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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,568	01/04/2002	Dean A. Seifert	020375-003000US	3306
20350	7590	04/17/2003	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ST CYR, DANIEL	
		ART UNIT	PAPER NUMBER	
		2876		

DATE MAILED: 04/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/040,556	TAKAYAMA ET AL.
	Examiner Daniel St.Cyr	Art Unit 2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 January 2002.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-33 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Specification***

1. The specification of the disclosure is objected to because the cross-reference section in page 1, the Patent Nos. are missing and a serial No. and/or a Patent No. is missing. Correction is required.

### ***Information Disclosure Statement***

2. The information disclosure statement filed 10/29/02 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

3. The information disclosure statement filed 10/29/02 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-7, 18, 19, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al, US, Patent No. 5,949,044, cited by the applicant.

Re claims 1, 6, 33, Walker et al disclose a method and apparatus for funds and credit transfers comprising: a central controller 130 for receiving money from a potential purchaser 110; a data storage device 255 for storing an electronic record of the received money in a store value account of the purchaser; receiving a request from the purchaser to transfer at least a portion of the received money to a recipient 120; and electronically sending the requested money to the recipient and debiting the store value account (see figures 11-12B and col. 9, line 64 to col. 11, line 2).

Re claim 2, wherein the money transfer location includes a device 235 that is communicable with a host computer 140, and wherein the stored value account is stored in the host computer after receiving information on the received money from the device (see figures 2 and 9).

Re claim 3, wherein the request to transfer the money is received at a server 130 that is communicable with the host 140 (figure 9).

Re claim 4, wherein the money is received from a credit card ( see col. 10, line 49).

Re claim 5, wherein the host computer is configured to electronically transfer the request money to the recipient (see figure 9 and col. 9, lines 15-55).

Re claim 7, wherein the request to receive payment is made from a telephone or a computer network (see col. 10, line 6).

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Re claims 18, 19, receiving information on an on-line fund/credit account from the recipient, wherein the on-line account is credited using on-line fund account (see col. 9, lines 38-63).

Re claim 21, further comprising receiving a sender key from the sender and assigning a confirmation code and confirming the code before providing the money to the recipient (see col. 11, line 50+).

Re claim 22, further comprising entering the account information into a point of sale device to credit the account (col. 7, lines 50+).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-17, 20, and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. The teachings of Walker et al have been discussed above.

Walker et al fail to disclose or fairly suggest all the payment means (i.e. debit card, cash card, check, etc.), including some of the details method steps, for conducting the transactions. However, these types of payments, such as checks, debit cards, cash card, are notoriously old and well known in the art for conducting financial transactions. With regard to some of the details method steps, such the sender has an option for receiving a message from the recipient, since the structural limitations are as recited and outlined in the prior art, such type of limitations are

obtained, and, therefore, obvious. Therefore, it would have been an obvious extension as taught by Walker et al.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-33 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-51 of U.S. Patent No. 6,488,203 (hereinafter '203 patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim invention is somehow a broader recitation of the '230 Patent. For instance, in claim 1 of the present invention and the '203 Patent, the applicant claims:

i)" A method for storing value that is usable to purchase goods or services, the method comprising: receiving money at a money transfer location from a potential purchaser; storing an electronic record of the received money in a store value account of the purchaser; receiving a request from the purchaser to transfer at least a portion of the received money to a recipient; electronically sending the requested money to the recipient and debiting the store value account" whereas in the '203 Patent, the applicant claims:

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i)"A method of performing a money transfer send transaction, the method comprising: providing a sender direct access to an employee of a financial services institution in order to receive transaction details from the sender; storing, on a data base, the transaction details provided by the sender, wherein the transaction details include a desired amount of money to be sent by the sender to a recipient; establishing a code that corresponds to the transaction details stored on the data base, wherein the code is established for use by the sender during the send transaction; storing the code on the data base such that the code is useable to identify the send transaction on the data base; entering the code into an electronic transaction fulfillment device in communication with the data base to retrieve the transaction details from the data base after the step of storing the code on the data base; and determining a collect amount, to be collected from the sender, based on the transaction details; wherein the code is not provided by or to the recipient for use by the recipient during the send transaction."

As to the claims 1-33 of instant application, the '203 Patent meet all the limitation as set forth in the claims 1-51.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-51 of '203 Patent as a general teaching for funds transfers, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the '203 patent and differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '203 patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. *IN re Vogel*, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C>FR> &1.78(d).

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Benton, US Patent No. 4,523,087, discloses a transaction verification system using optical coupling data communication link. Claus, US Patent No. 5,461,217, disclose a secure money transfer techniques using smart cards. Marcus et al, US Patent No. 5,650,604, disclose a system and method for electronic transfer of funds using an automated teller machine to dispense the transferred funds. Aoki et al, US patent No. 5,691,525, disclose a data transfer system and data transfer terminal device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 703-305-2656. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7721 for regular communications and 703-308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Daniel St.Cyr  
Examiner  
Art Unit 2876

DS  
April 14, 2003

A handwritten signature in black ink, appearing to read "Daniel St.Cyr", is written over a horizontal line. The signature is fluid and cursive, with a large loop on the right side.